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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SLACK, NAOKO N

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,912

Applicant(s)

ROSENTHAL ET AL.

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 29-36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-28 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 26, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Restriction

During a telephone conversation with Mainish B. Vyas on August 23, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-28, drawn to a floor system, classified in class 52, subclass 592.1.
- II. Claims 29-36, drawn to a method of manufacturing a floor panel, classified in class 156, subclass 307.5.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the floor panel can be manufactured by another and materially different process. While Applicant has claimed the steps of forming integral latching and securing portions on floor panels and applying a coating and

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sealant to the latching and forming portions, sealants can be applied to floor panels prior to the forming of latching and securing portions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 112 (b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6, 8-10 are rejected under 35 USC 102(e) as being clearly anticipated by US Patent 6,588,166 to Martensson et al.

Claims 1 and 6:

Martensson et al. discloses a floor system comprising a surface layer (18, Figure 9) and a core layer (11, Figure 9) with an integral latching portion (right side of member, Figure 9) and an integral securing portion (left side of member, Figure 9), the latching and securing portions configured to mate interlockingly. Martensson et al. further discloses the use of an adhesive coating disposed on the latching and securing portions (column 8, lines 23-29), a sealant such as oil, wax, or paint disposed on the latching and securing portions to inhibit the ingress of moisture (column 8, lines 4-8), and an adhesive that acts as a sealant (column 8, lines 32-35). An adhesive coating that acts as a sealant has dual properties: an adhesive to bond separate members and a sealant to inhibit ingress of moisture. Since the sealant has not been claimed to be of a composition different from the adhesive, an adhesive that adheres and seals meets the limitations of adhesive and sealant.

Claim 2:

The adhesive coating is applied to both the latching and securing portions of the floor members (column 8, lines 23-29).

Claims 3 and 8:

The adhesive coating adhesively bonds to the floor members as the joints are pre-glued at the factory (column 8, lines 14-17 and lines 23-29).

Claim 9:

The core layer (11, Figure 9) comprises a wood/resin composite (column 5, lines 15-20).

Claim 10:

The surface layer comprises a laminate layer (column 6, lines 18-22).

Claims 1, 7, and 13-15 are rejected under 35 USC 102(e) as being clearly anticipated by US Patent Application Publication 2003/0141004 to Palmblad et al.

Claim 1:

Palmblad et al. discloses a floor system comprising a surface layer (page 1, paragraph 2, lines 7-9) and a core layer (page 1, paragraph 2, lines 4-7) with an integral latching portion and an integral securing portion (page 1, paragraph 2, lines 9-10), the latching and securing portions configured to mate interlockingly (page 1, paragraph 4, lines 6-7). Palmblad et al. further discloses the use of an adhesive coating disposed on the latching and securing portions (page 1, paragraph 4, lines 3-7), the adhesive also acting as a sealant to inhibit ingress of moisture (page 1, column 2, lines 7-16). As stated above, since the sealant has not been claimed to be of a composition different from the adhesive, an adhesive that adheres and seals meets the limitations of adhesive and sealant.

Claim 7:

Palmblad et al. discloses that the glue expands and merges over the edges of the joint between adjacent floor members and acts as a sealant against further ingress of liquid (page 1, column 2, lines 7-16). The expansion of the glue disposes the sealant in the area between the latching and securing portions and the upper surface of the floor member. Therefore, while some of the glue between the latching and securing portions will act as an adhesive, the expanded glue will act as a sealant.

Claims 13 and 14:

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The adhesive coating provides a sliding interface between the latching and securing portions upon engagement of the first and second members (page 3, paragraph 34, lines 7-9), which facilitates positional adjustment of the members with respect to one another.

Claim 15:

Palmblad et al.'s adhesive acts as a sealant and is disposed at least adjacent to an upper surface of the assembled floor members (page 1, column 2, lines 7-16).

Claims 1, 6 and 7 are rejected under 35 USC 102(e) as being clearly anticipated by US Patent Application 2003/0024199 to Pervan et al.

Claim 1:

Pervan et al. discloses a floor panel with sealing means comprising first and second layered floor members, each layered member comprising a surface layer (31, Figure 16a), a core layer comprising an integral latching portion (10, Figure 16a) and an integral securing portion (9, Figure 16a), the latching and securing portions configured to interlock, and a sealant (20, Figure 16a) disposed on the latching and securing means. While Pervan et al. does not illustrate adhesive on the latching and securing portions, Pervan et al. states that the invention is especially suited for use in floors with mechanical locking and a joint system that employs adhesive (page 5, paragraph 54, lines 4-6). Pervan et al. also states glue is applied along the tongue and groove joints (page 1, paragraph 9, lines 1-2 and page 3, paragraph 29, lines 4-8). Pervan et al.'s invention improves the glued

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floor joints by sealing the joint edge at various locations, preventing the ingress of moisture (page 3, paragraph 36, lines 1-5).

Claim 6:

Pervan et al. discloses sealant disposed at least along the latching and securing portions (9 and 10, Figure 16a) where glue is applied (page 3, paragraph 29, lines 7-8).

Claim 7:

In another embodiment, Pervan et al. discloses sealant disposed beneath the upper surface of the top layer (31, Figure 11b) and above the latching and securing portions where adhesive coating is applied (9 and 10, Figure 11b).

Claim Rejections – 35 USC 103

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5 and 12 are rejected under 35 USC 103(a) as being unpatentable over US Patent 6,588,166 to Martensson et al. in view of US Patent Application Publication 2002/0148551 to Knauseder.

Claims 4 and 5:

While Martensson et al. discloses the use of factory-applied adhesives and sealants on the latching and securing portions, Martensson et al. fails to specify adhesive coatings on adjacent floor members that bond cohesively without activation. However,

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Knauseder discloses interlocking floor members whose joints are coated with contact adhesives that cohesively bond without activation when adjacent members are pressed together (page 2, paragraph 2).

In view of Knauseder, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use an adhesive that cohesively bonds to itself on Martensson et al.'s flooring joints, as Martensson et al. states that glue or other sealing substances can be applied in the vicinity of the joint (column 7, line 66- column 8, line 2).

Claim 12:

While Martensson et al. discloses the use of factory-applied adhesives and sealants on the latching and securing portions, Martensson et al. fails to specify adhesive coatings on adjacent floor members that have a substantially non-tacky surface. However, Knauseder discloses contact adhesives that form a thin surface film that appears to be dry, therefore non-tacky, until the adhesive-coated panels are pressed together (page 2, paragraph 22). As defined by Applicant, 'non-tacky' is defined as diminished adhesion to foreign objects (page 11, lines 1-12).

In view of Knauseder, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use an adhesive that has a substantially non-tacky surface on Martensson et al.'s flooring joints, as Martensson et al. states that glue or other sealing substances can be applied in the vicinity of the joint (column 7, line 66- column 8, line 2).

Allowable Subject Matter

Claims 16-28 are allowed.

Objection to Claims, Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (703) 305-0315. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Carl D. Friedman can be reached at (703) 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

NS
August 23, 2004



Naoko Slack
Primary Examiner